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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/628,786	07/28/2003	Thomas Monschein	101769-231 / tesa AG 1612	4515
27384	7590	03/10/2006	EXAMINER JOLLEY, KIRSTEN	
NORRIS, MCLAUGHLIN & MARCUS, PA 875 THIRD AVENUE 18TH FLOOR NEW YORK, NY 10022			ART UNIT 1762	

DATE MAILED: 03/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/628,786

Applicant(s)

MONSCHEIN ET AL.

Examiner

Kirsten C. Jolley

Art Unit

1762

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 February 2006.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
4a) Of the above claim(s) 8 and 9 is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-7 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 7/28/03, 3/9/05.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Applicant's election with traverse of Group I, claims 1-7, in the reply filed on February 24, 2006 is acknowledged. The traversal is on the ground(s) that the adhesive tape of Group II is only able to be fabricated using the method of Group I, and because claims 8-9 (Group II) are ultimately dependent upon claim 1 and therefore are drawn to the same process and are not distinct inventions. This is not found persuasive because the product (claims 8-9) must be patentable on its own merits. *In re Stephens*, 145 USPQ 656. *In re Kern*, 129 USPQ 345. The patentability of a product is based on the product limitations and not on the recited process steps. *In re Brown*, 173 USPQ 685. Therefore, when examining claims directed to a coated product, the applicable art includes art directed to Applicant's final coated substrate produced by any method that would reasonably give that same product. Applicable art for a method of coating do not necessarily encompass all the fields of search required for product claims and therefore there is a burden in examining the two classes of invention. Further, the considerations used for examining method claims are different than those used for examining product claims. It is the Examiner's position that there is an additional burden based on the different issues that arise in examining method versus article claims.

The requirement is still deemed proper and is therefore made FINAL.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

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The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 7 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 7 is vague and indefinite because it claims that the substrate has a viscosity of <2000 mPa*s. Solid objects such as a backing web substrate cannot have a viscosity. (It is noted that the specification at the top of page 9 states that the *adhesive coating* has a viscosity of <2000 mPa*s.)

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-6 are rejected under 35 U.S.C. 102(b) as being anticipated by Speeney (US 5,922,402).

Speeney discloses a process for producing an adhesive tape with a stripe-shaped application of the adhesive on a backing material, where the backing web is guided past a dip roll which is in contact with the backing web, the roll rotates in a bath of adhesive thereby transferring adhesive to the roll surface, and the roll is designed such that after the roll has run through the bath at least one stripe on the roll surface is adhesive-free. See Figures 6-7 and col. 5, lines 15-67.

As to claims 2-4, Speeney teaches that the roll surface is completely smooth, and that there is located between the bath and backing material, downstream of the roll in the direction of rotation, a comb-shaped stripper whose teeth remove the adhesive in strip form from the surface of the roll. (It is noted that claim 3 only requires that the depth and width of the teeth are *preferably* adjustable, which is interpreted as an optional feature.) In Speeney's process, the roll rotates in the web direction.

As to claims 5-6, Speeney teaches use of a doctor blade downstream of the roll in the web direction, the doctor blade being a circular rod around which a wire is wrapped (col. 4, lines 47-51 and Figure 3).

Claim Rejections - 35 USC § 103

6. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Speeney as applied to claim 1 above, and further in view of Carey et al. (US 4,814,204) or Von Hofe (US 2,102,984) or Faulkner, Jr. et al. (US 2,754,796).

Claim 3 is alternatively rejected in view of Carey et al. or Von Hofe or Faulkner, Jr. et al. Carey et al., Von Hofe, and Faulkner, Jr. et al. each disclose use of a comb-shaped stripper having teeth to remove a coating solution in stripe form from the surface of an applicator roll. It would have been obvious to have substituted the stripper of Speeney with that of Carey et al., Von Hofe, or Faulkner, Jr. et al. with the expectation of similar and equivalent results since the strippers each perform the same function of removing coating material from a roll prior to contact with a substrate in order to form a striped coating pattern on the substrate.


Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Hough (US 1,568,605) and Gilchrist (US 3,073,716) are additionally cited to teach the state of the art with respect to coating in a striped pattern.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kirsten C. Jolley whose telephone number is 571-272-1421. The examiner can normally be reached on Monday to Wednesday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Timothy Meeks can be reached on 571-272-1423. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Kirsten C Jolley
Primary Examiner
Art Unit 1762

kcj